

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte EDWARD J. WUJCIGA

Appeal No. 2002-0296
Application No. 09/248,553

ON BRIEF

Before STAAB, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 and 3 to 6. Claims 7 to 12 have been withdrawn from consideration under 37 CFR § 1.142(b) as being drawn to a nonelected invention. Claim 2 has been canceled.

We REVERSE.

BACKGROUND

The appellant's invention relates to a decorative, durable, light reflective vehicle license plate cover (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Leopold et al. (Leopold)	1,664,302	Mar. 27, 1928
DeLaquil, Jr. (DeLaquil)	4,891,895	Jan. 9, 1990
Lucier	5,623,776	Apr. 29, 1997
Sersiron	FR 2 543 499	Oct. 5, 1984

Claim 6 stands rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1 and 3 to 6 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims 1 and 3 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sersiron in view of DeLaquil.

Claims 4 to 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sersiron in view of DeLaquil as applied to claims 1 and 3, and further in view of Lucier.

Claims 1 and 3 stand rejected under 35 U.S.C. § 103 as being unpatentable over Leopold in view of DeLaquil.

Claims 4 to 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Leopold in view of DeLaquil as applied to claims 1 and 3, and further in view of Lucier.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 12, mailed April 5, 2001) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 10, filed January 29, 2001) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Initially we note that on pages 2 and 4 of the brief the appellant seeks our review of the decision by the examiner (Paper No. 7) refusing entry of the amendment after final filed August 7, 2000 (Paper No. 6). However, the refusal by the examiner to enter the appellant's amendment after final rejection relates to a petitionable matter and not to an appealable matter. See In re Schneider, 481 F.2d 1350, 1356-57, 179 USPQ 46, 51 (CCPA 1973) and In re Mindick, 371 F.2d 892, 894, 152 USPQ 566, 568 (CCPA 1967). See also Manual of Patent Examining Procedure § 1002(c), item 3(b) and § 1201. Thus, the relief sought by the appellant would have been properly presented by a petition to the Commissioner under 37 CFR §§ 1.127 and 1.181 instead of by appeal to this Board. Accordingly, we will not further consider this issue.

The enablement rejection

We will not sustain the rejection of claim 6 under 35 U.S.C. § 112, first paragraph.

The full basis for this rejection as set forth in the answer (p. 3) is that "[t]he specification fails to disclose how the laser engraving is disposed in the interior of the cover as shown in Figure 5." However, this is insufficient to meet the examiner's threshold burden of establishing lack of enablement under the first paragraph of 35 U.S.C. § 112 for the reasons that follow.

An analysis of whether the claims under appeal are supported by an enabling disclosure requires a determination of whether that disclosure contained sufficient information regarding the subject matter of the appealed claims as to enable one skilled in the pertinent art to make and use the claimed invention. The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation. See United States v. Telectronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), cert. denied, 109 S.Ct. 1954 (1989); In re Stephens, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976).

In order to make a nonenablement rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. See In re Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of

protection provided by a claim is not adequately enabled by the disclosure). A disclosure which contains a teaching of the manner of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. § 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. Assuming that sufficient reason for such doubt exists, a rejection for failure to teach how to make and/or use will be proper on that basis.¹ See In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). As stated by the court,

it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.

In re Marzocchi, 439 F.2d at 224, 169 USPQ at 370.

Thus, the dispositive issue is whether the appellant's disclosure, considering the level of ordinary skill in the art as of the date of the appellant's application, would have

¹ Once the examiner has established a reasonable basis to question the enablement provided for the claimed invention, the burden falls on the appellant to present persuasive arguments, supported by suitable proofs where necessary, that one skilled in the art would be able to make and use the claimed invention using the disclosure as a guide. See In re Brandstadter, 484 F.2d 1395, 1406, 179 USPQ 286, 294 (CCPA 1973).

enabled a person of such skill to make and use the appellant's invention without undue experimentation. The threshold step in resolving this issue as set forth supra is to determine whether the examiner has met his burden of proof by advancing acceptable reasoning inconsistent with enablement.² This the examiner has not done. In fact, the examiner has not set forth any rationale as to why the appellant's disclosure, considering the level of ordinary skill in the art as of the date of the appellant's application, would not have enabled a person of such skill to make and use the appellant's invention without undue experimentation.

For the reasons set forth above, the decision of the examiner to reject claim 6 under 35 U.S.C. § 112, first paragraph, is reversed

The indefiniteness rejection

We will not sustain the rejection of claims 1 and 3 to 6 under 35 U.S.C. § 112, second paragraph.

² This is usually accomplished by considering the following factors in determining whether a disclosure would require undue experimentation: (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. See In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) citing Ex parte Forman, 230 USPQ 546, 547 (Bd. Pat. App. & Int. 1986).

The examiner determined (answer, p. 3) that the claims under appeal directed to a plate cover were indefinite due to the appellants use of the transition phrase "consisting of" in claim 1 while not defining all the elements of the plate cover (e.g., holes in the plate cover and indicia on the plate cover).

In our view, claims 1 and 3 to 6 are definite as required by the second paragraph of 35 U.S.C. § 112.³ Claim 1 recites an improved durable and decorative vehicle license plate cover, the cover **consisting of** a single, flat, rigid, solid mar-resistant plate of optically transparent plastic having a thickness of about 0.5 inch, wherein the plate has a front surface, an opposite rear surface and sides interconnecting the front and rear surfaces with the sides sloping forwardly and inwardly at an angle of about 30-60 degrees from the rear surface to the front surface. While claim 1 does not recite that the plate cover includes holes for attaching the plate cover to a vehicle license plate or that the plate cover bears indicia viewable from the sides of the plate cover,⁴ these limitations just define further aspects of the plate cover not additional elements (e.g., license plate, screws). Thus, the appellant has correctly used the transition phrase

³ Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

⁴ These limitation appear in dependent claim 4.

"consisting of" in claim 1 and the claims under appeal are definite as required by the second paragraph of 35 U.S.C. § 112.

For the reasons set forth above, the decision of the examiner to reject claims 1 and 3 to 6 under 35 U.S.C. § 112, second paragraph, is reversed.

The obviousness rejections

We will not sustain the rejection of claims 1 and 3 to 6 under 35 U.S.C. § 103.

All the claims under appeal require the license plate cover to consist of a single, flat, rigid, solid mar-resistant plate of optically transparent plastic having a thickness of about 0.5 inch. However, these limitations are not suggested by the applied prior art. In that regard, while DeLaquil does teach a transparent license plate cover made from acrylic or polycarbonate material, DeLaquil does not teach or suggest a license plate cover consisting of a rigid transparent plastic having a thickness of about 0.5 inch. To supply this omission in the teachings of the applied prior art, the examiner made determinations (answer, pp. 4 and 5) that a thickness of 0.5 inch would have been

obvious to an artisan. However, this determination has not been supported by any evidence that would have led an artisan to arrive at the claimed invention.⁵

In our view, the only suggestion for modifying either Sersiron or Leopold in the manner proposed by the examiner to meet the above-noted limitation stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that the decision of the examiner to reject claims 1 and 3 to 6 under 35 U.S.C. § 103 is reversed.

⁵ Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg., Inc. v. SGS Importers Int'l., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), cert. denied, 117 S. Ct. 80 (1996), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." Thus, when an examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002). See also In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

CONCLUSION

To summarize, the decision of the examiner to reject claim 6 under 35 U.S.C. § 112, first paragraph, is reversed; the decision of the examiner to reject claims 1 and 3 to 6 under 35 U.S.C. § 112, second paragraph, is reversed; and the decision of the examiner to reject claims 1 and 3 to 6 under 35 U.S.C. § 103 is reversed.

REVERSED

LAWRENCE J. STAAB
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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